UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW Aug-07

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

COPY MAILED

AUG 28 2007

OFFICE OF PETITIONS

In re Application of :
Tertius E. Dreyer :
Application Number: 10/606783 : ON PETITION
Filing Date: 06/27/2003 :
Attorney Docket Number: 4000-3 :
:

This is a decision in reference to the paper entitled "PETITION TO REVIVE ABANDONED PATENT APPLICATION," which, in view of petitioner's statements therein, is treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is **DISMISSED**.

This application became abandoned on 10 May, 2006, for failure to timely submit a proper reply to the final Office action mailed on 10 February, 2006, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on 21 May, 2007.

Petitioner's counsel states:

> After a final office action was issued on February 10, 2006, a telephone interview was conducted with Primary Examiner Douglas Hess in early May of 2006. During the interview, several amendments were proposed to the Examiner. After consideration, Examiner Hess telephoned the undersigned indicating that he would allow the application once those amendments were filed in a formal amendment and that there was no need to file an RCE. That amendment was filed on May 9, 2006 and can be seen in the Public PAIR system.

Petitioner essentially asserts that the examiner promised to allow the application based on the after-final amendment filed on

9 May, 2006. In support, petitioner has further provided a facsimile copy of a proposed Notice of Allowability furnished by the examiner as evidence of the examiner's intent to allow the application.

Petitioner's argument has been considered, but is not persuasive.

37 CFR 1.135 states, in pertinent part.

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
>
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

Further, the Office action mailed on 10 February, 2006, states that a shortened statutory period for reply is set to expire 3 months … from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

37 CFR 1.2 states that the action of the U.S. Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. Moreover 37 CFR 1.116 is manifest that the admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135.

The showing of record is that petitioners did not timely file a proper reply to the final Office action mailed on 10 February, 2006. To this end, the amendment filed on 9 May, 2006, was determined by the examiner not to place the application in condition for allowance, as indicated on the Advisory Action

mailed on 16 May, 2007. As such, the application became abandoned as a matter of law for failure to timely and properly reply to the final Office action mailed on 10 February, 2006.

Furthermore, with regard to petitioner's assertion that the examiner agreed that no action was required on the part of petitioner to prevent the application from becoming abandoned, the showing of record does not support that contention: There is simply no evidence that petitioners timely filed a proper amendment in response to the final Office action mailed on 10 February, 2006.

Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.[1] The rule clearly indicates that the mere filing of an amendment does not save the application from abandonment. Only the filing of a Notice of Appeal, Request for Continued Examination and submission under 37 CFR 1.114, or continuing application guarantees the pendency of the application, not filing an amendment after final rejection. Thus, the application became abandoned due to petitioner's failure to file a Notice of Appeal, RCE and submission, or continuing application prior to the period for reply to the final Office action, and not because of any error on the part of the Office.

Further, the official written record contains no indication that the examiner had agreed that the application was allowable based on the amendment filed on 9 May, 2006. The fact that the examiner faxed a courtesy copy of a Notice of Allowability, which is not part of the official record, moreover, does not indicate in itself that the examiner intended to allow the application without further action by applicants. The facsimile cover page from the examiner states that no Notice of Allowance has been mailed. Rather, the showing of record suggests that the examiner intended to mail a Notice of Allowance *upon receipt of a timely and proper amendment*.

In summary, to the extent that petitioner's counsel believed that the examiner had agreed that no further action was needed to avoid abandonment of the application, there is no showing in the written record to support that allegation. As MPEP 711.03(c) states, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or

---

[1] MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-300 (CCPA 1964); Krahn v. Commissionerr, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

the MPEP is not rendered "unavoidable" due to: (A) the applicants' reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicants of any deficiency in sufficient time to permit the applicant to take corrective action.[2]

The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.[3] Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.[4]

As such, the showing of record is that the abandonment resulted from the failure of petitioners to file a timely and proper response to the final Office action, rather than an error on the part of the USPTO.

As such the application is properly held abandoned.

The petition is **DISMISSED.**

Petitioner may wish to consider filing a petition to revive under 37 C.F.R. 1.137(b).

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the date of this decision.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

---

[2] See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

[3] Link v. Wabash, 370 U.S. 626, 633-34 (1962).

[4] Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions